

REMARKS/ARGUMENTS

Amendments in General

1. Claims 1, 5, 8, and 15 have been amended to clarify that the menu of the present invention is presented to a customer at the time of ordering and that selections which are selected are prepared food selections. These amendments add no new matter to the specification and acceptance of these amendments is respectfully requested.
2. Claims 5 and 6 have been amended for clarity.
3. Claims 9-12 have been amended to for clarity by unifying language throughout these claims.
4. Claims 13 and 16 have been amended to increase the clarity of the particular application.
5. None of these amendments add any new matter to the specification and acceptance of these amendments is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

6. Claim 5 of the application has been amended so as to provide enhanced clarity. As currently amended claim 5 reads as follows:

5. (Currently Amended) The restaurant format of claim 1 in which preparing the menu selection in a manner that results in a meal ~~that is compliant with a chosen diet or nutrition plan selected by a customer~~ includes utilizing preselected choice of ingredients, cooking methods, and side dishes.

Applicant respectfully submits that this claim as amended overcomes the Examiners rejections and respectfully requests that this claim as amended be accepted.

Claim Rejections - 35 USC § 102

7. The Examiner rejected claims 1-14 under §102(b) as being anticipated by Brown.
8. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.”

Richardson v. Suzuki Motor Co., 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

9. Claims 1, 5, and 8 have been amended to clarify that the menu of the present invention is presented to a customer at the time of ordering and that this menu indicates various diet indicators with which the various food selections on the menu can be prepared.

10. This is fundamentally different from the Brown reference. The Brown reference is directed to a system and method for coordinating various electronically stored restaurant menus together with a pre-selected profile whereby the system selects choices from the various restaurant menus based upon the pre-entered profile and presents these items to the customer at the time of ordering.

11. As is described in the application the indicators which are shown in Figures 4, 5, and 6 are part of the data storage features which store the menu choices and the individual customer profiles. These are not seen by a customer at the time of ordering like the present invention does.

12. Instead, these data storage blocks shown in Figures 4, 5, and 6 serve as a file from which information is harvested so as to provide a particular user with menu choices that are in adherence with his/her preselected choices. The indicators which are present in the present invention are not present in Brown because Brown only presents menu choices that are in accordance with a profile. See Col. 8 line 12- Col. 10 line 7.

13. There is no need for the use of the indicators which are present in the claimed invention because the Brown reference prescreens choices that are not included in a particular profile away from being presented and keeps these choices from being presented to a user.

14. Furthermore, the way that food is prepared also has a bearing on the dietary value and function of the meal. This is not accounted for in the Brown reference unless the party includes specific special ordering instructions as a part of the order, or includes this as a part of their profile.

15. The present invention does not require the prior placement of specific ordering profile nor does it require special ordering in order to ensure that food is prepared according to a specific standard or in compliance with particular standards. Upon selection of a particular dish the party by virtue of the indicators on the menu knows that a particular menu item will be made in compliance with a particular standard.

Claim Rejections - 35 USC § 103

16. The Examiner rejected claims 15-17 under §103(a) as being unpatentable (obvious) in view of Brown when combined with Tsai.

17. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

18. As previously described the Brown reference does not anticipate the present invention. The Brown reference does not present a menu with indicators at the time of ordering. The Brown reference only works for persons who have previously entered their information into the system and is not a general all purpose menu that is presented to all customers at the time of ordering. There are also other factors related to the presentation of menu choices that are included in the present invention and which are not included in the Brown reference. Therefore claims 15-17 are not rendered obvious because not all of the required elements to make a *prima facie* case of obviousness are present.

19. Furthermore, there is no motivation or suggestion within the references for making the modifications that the applicant has made.

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The combination of references which has been made by the Examiner has no support within the references themselves that teach doing what the Applicant has done. The Brown

reference teaches the use of a computerized system to prescreen restaurants and menu items according to a presented profile. The Tsai reference teaches a table-top grill for cooking foods. There is no suggestion or motivation within these references to make the combination which has been put forth by the Examiner nor is there any suggestion or motivation from the prior art.

20. While the claimed concept is admittedly simple when viewed in hindsight, it is this hindsight position that cannot be utilized as the frame of reference from whence the determination of obviousness is to be made.

To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

21. Neither the references which have been cited by the Examiner nor the prior art itself make any suggestion for modifying the references or making the modifications that the Applicant has claimed. As such Applicant respectfully submits that the present invention is not anticipated by the prior art and requests that the Examiner's rejection be withdrawn.

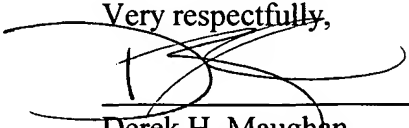
Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 10th day of August. 2006

Very respectfully,



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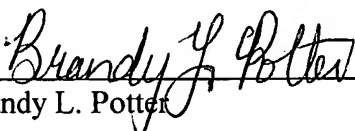
Examiner Jeffrey A. Shapiro
Serial # 10/677,597

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